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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,962	01/07/2004	Takashi Suzuki	2003_1924A	4501

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EXAMINER

SRIVASTAVA, KAILASH C

ART UNIT PAPER NUMBER

1655

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/751,962

Applicant(s)

SUZUKI ET AL.

Examiner

Dr. Kailash C. Srivastava

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 5-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>03.05.2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's response filed 31 May 2006 to Office Action mailed 12 May 2006 is acknowledged and entered.

Claims Status

2. Claims 1-9 are pending.

Restriction/Election

3. Applicants' election without traverse of Group I, Claims 1-4 filed 31 May 2006 to Office Action mailed 12 May 2006 is acknowledged and entered. Since the election is made without traverse, the restriction requirement is deemed proper and is made FINAL.

Accordingly, Claims 4-9 are withdrawn from further consideration as being directed to a non-elected invention. See 37 CFR §1.142(b) and MPEP § 821.03.

Objection To Specification

4. The specification is objected to because Applicants have not recited the claimed priority data at Line one of first page of specification. Applicant should indicate at the first line of the first page of the specification that the instant application Claims priority to Japanese Patent Application Number 001317/2003 filed 07 January 2003, as follows.

"This application Claims Priority to Japanese Patent Application 001317/2003 filed 07 January 2003".

Claim Rejections – 35 U.S.C. § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4 are rejected under 35 U.S.C. §102(b) as anticipated by Schultz (Methods: A

comparison to Methods in Enzymology, 1999, Volume 17, Pages 161-172).

Claims recite a method to prepare a yeast extract via rupturing frozen yeast cells frozen with liquid nitrogen and mashed in frozen state with pestle and mortar, subsequently separating the 50000 molecular weight fraction from high molecular weight fraction to obtain a concentrated yeast fraction...

Schultz teaches a method to freeze harvested yeast cells in liquid nitrogen Page 163, Column 2, Lines 13-15, break said frozen yeast cells in a pestle and mortar (Page 164, Column 1, Lines 24-40 and Column 2, Lines 19-53), suspending the frozen mass in to a given quantity of thawing buffer to extract the yeast extract and subsequently thawing the suspended mass by holding the container between palms of hand (Page 166, Column 2, Lines 9-41). Subsequently, the extracted material is separated via centrifugation (Page 166, Column 2, Line 45 to Page 167, Column 1, Line 2), the supernatant dialyzed in a 8 kilo-Dalton molecular weight cut off dialysis tube, the dialyzed material is lash frozen in liquid nitrogen and the protein content of the extracted dialyzed material quantified (Page 167, Column 1, Lines 1-20). Even though Schultz does not detail that the said yeast extract is prepared for protein synthesis, the claims remain obvious to an artisan of ordinary skill because preparing the protein from said cell free yeast extract is the functional intended use of said yeast extract prepared according to said method and is accordingly, not given any patentable weight.

Therefore, the reference deems to anticipate the cited claims.

Other Prior Art

7. The following prior art made of record and not relied upon is considered pertinent to Applicants' disclosure.

- Hussain et al., Gene, Volume 46, Pages 13-23, 1986.

Claim Rejections - 35 U.S.C. § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

9. Claims 1-4 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

- The recitation, "extract" in Claim 1 renders that Claim vague and indefinite because the term "extract" in and of itself, does not adequately delineate its metes and bounds. This term is best defined as a product-by process since product-by-process claims are intended to define products that are otherwise difficult to define (and/or distinguish from the prior art). For example, from what part(s) of the organism is the extract obtained? Extraction with one of various distinct solvents, as well as from particular parts of an organism may lead to a different end product and therefore, clearly defining parts from where the extract is obtained and how the extract is prepared has a profound impact on the final product with respect to the presence, absence, amounts, and/or ratios of active ingredients therein and, thus, its ability to provide the necessary functional effect(s) instantly claimed and/or disclosed. Since the extract itself is clearly essential to the claimed invention, the steps(s) by which the claimed extract is obtained are also clearly essential and, therefore, must be recited in the claim language itself (i.e., as a product-by-process). Please note that although claims are interpreted in light of the specification, critical limitations from the specification cannot be read into the claims (see, e.g., *In re Van Guens*, 988 F.2d 1181, 26 PSPG2d 1057 (DED. Cir. 1991). Accordingly, without the recitation of all these critical limitations as set forth above, the cited claim does not adequately define the instant invention.

All other claims depend directly from the rejected claims (1, 15 or 20) and are, therefore, also rejected under 35 U.S.C. §112, second paragraph for the reasons set forth

Conclusion


10. For reasons aforementioned, no Claims are allowed.

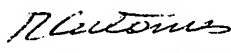
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kailash C. Srivastava whose telephone number is (571) 272-0923. The examiner can normally be reached on Monday to Thursday from 7:30 A.M. to 6:00 P.M. (Eastern Standard or Daylight Savings Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Terry McKelvey, can be reached on (571)-272-0775 Monday through Friday 8:30

A.M. to 5:00 P.M. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding may be obtained from the Patent Application Information Retrieval (i.e., PAIR) system. Status information for the published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (i.e., EBC) at: (866)-217-9197 (toll-free). Alternatively, status inquiries should be directed to the receptionist whose telephone number is (703) 308-0196.


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RALPH GITOMER
PRIMARY EXAMINER
GROUP 1200

September 18, 2006